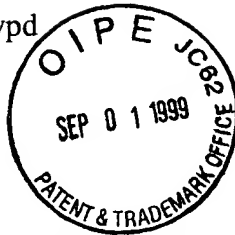


K:\DTHIBODE\TEX\98-01A\ids3.wpd
WP 7.0
DJT:MLM
August 30, 1999



PATENT APPLICATION
DOCKET NO.: TEX98-01A

#16
IDS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: David M. Mayes
Application No.: 09/019,667 Prior Group Unit: 2877
Filed: February 6, 1998 Prior Examiner: Nguyen, T.

Title: GRAIN QUALITY MONITOR

CERTIFICATE OF MAILING	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Assistant Commissioner for Patents, Washington, D.C. 20231	
on <u>08-30-99</u>	<u>Mariah Moorhead</u>
Date	Signature
<u>Mariah Moorhead</u>	
Typed or printed name of person signing certificate	

INFORMATION DISCLOSURE STATEMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

In keeping with the duty of candor and good faith owed to the Patent and Trademark Office, Applicant's attorneys hereby wish to bring the following information to the attention of the Examiner. Specifically, we ask that the Examiner consider certain activities of the inventor which occurred more than 12 months before December 30, 1995, which is the earliest claimed filing date of the above application. It is respectfully requested that this additional information be considered prior to the issuance of a first Office Action in this continuation application.

SEP 03 1999

TECHNOLOGY CENTER 2800

INTRODUCTION

As set forth in the Second Declaration of David M. Mayes attached hereto as Exhibit A, on or about December 5, 1995 the inventor sent a letter to a company called Micro-Trak located in Eagle Lake, Minnesota. In that letter Dr. Mayes proposed that a grain monitor "could be implemented to analyze grain and other agricultural products in real time while being harvested." The letter further suggested that the device "could be mounted directly in a combine or similar implement". Dr. Mayes' letter to Micro-Trak further proposes possible constituents which could be analyzed, an estimated cost, and other specifications for the proposed units.

However, at the time of sending the December 5, 1995 letter to Micro-Trak, Dr. Mayes had not yet actually implemented any real time grain monitor in a combine. Indeed, the first sketch of a spectrophotometer attached to a combine was made in Dr. Mayes' notebook on January 24, 1996. Dr. Mayes further elaborated on the details of the proposed grain monitor in connection with a proposal made to Lockheed Idaho Engineering on January 26, 1996. But even as of January 24 and January 26, 1996, dates which are less than one year before the earliest claimed filing date of the above application, it is clear that Dr. Mayes was still seeking funding to initially develop his idea, and was not offering a product for sale.

DISCUSSION

A. The Invention Was Not On-Sale More Than One Year Before the Earliest Claimed Filing Date

Title 35 of U.S. Code §102 (b) provides that an inventor is not entitled to a patent if the invention was "... on sale in this country more than one year prior to the date of application for patenting in the United States". The ultimate determination of whether or not an invention was on sale is a question of law. This "on-sale bar" serves the purpose of preventing inventors from exploiting the commercial value of their inventions while deferring the beginning of the statutory term. In making a determination as to whether an invention was "on sale," all of the

circumstances surrounding the sale or the offer to sell, including the stage of development of the invention and the nature of the invention, must be considered. See, generally, *Micro Chemical, Inc. v. Great Plains Chemical Company*, 103 F.3d 1538, 1544, 41 USPQ2d 1238, 1243 (Fed.Cir. 1997). This and other decisions of the Federal Circuit have essentially held that an invention may not be considered to have been on-sale if it was not physically reduced to practice at the time of the offer.

For example, a patent will not be held invalid if the inventor or another offered for sale, before the critical date, the mere concept of the invention. "If the inventor had merely a conception or was working towards development of that conception, it can be said that there [was not] . . . any invention' which could [have been] placed on sale." *UMC Electronics Co. v. United States*, 816 F.2d 647, 656-57, 2 USPQ2d 1465, 1471-72 (Fed. Cir. 1987). This is indeed the case here, where Dr. Mayes' December 5, 1995 letter was clearly intended to seek initial funding to develop his idea, which had not progressed beyond the conceptual stage.

The United States Supreme Court has recently held, in the case of *Pfaff v. Wells Electronics, Inc.*, ___ U.S. ___, 119 S.Ct. 304, 312, 48 USPQ2d 1646 (1998), that a prior reduction to practice is not necessarily a prerequisite to the application of the on-sale bar. In that case, the Supreme Court set forth a two-step test for determining whether an invention has been placed on sale.

According to the first part of that test, the invention must be the subject of a commercial offer for sale. In the present case, it is clear that Dr. Mayes was making a proposal to Micro-Trak to initially fund the development of his idea to incorporate a spectrophotometer into a harvesting device. It is also clear Dr. Mayes did not have anything at that time which could be offered for sale commercially. Indeed, he had not even completed an initial sketch of the device at that time.

Secondly, the invention must have been "ready for patenting" at the time of the offer for sale. In the *Pfaff* case, the Supreme Court held that this condition may be satisfied in two ways -- (1) by proof of actual reduction to practice before the critical date, or (2) by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficient to enable a person skilled in the art to practice the invention.

Now in the present case, Dr. Mayes' first working prototype was not completed until later in 1996. Dr. Mayes thus had not yet actually reduced to practice his invention prior to the critical date. The first "ready for patenting" condition is, therefore, not met.

The January 1996 proposal to Lockheed Idaho Engineering is further evidence of the fact that Dr. Mayes had not yet completed even an initial design. That proposal was also a request for money for initial development of the idea. It says "the device should adapt PBS type detector array technology to the existing photospectrometer" and "a specific sensor head suitable for real time analysis of wheat still needs to be designed."

As to the second *Pfaff* "ready for patenting" condition, we note that in the December 5, 1995 letter, Dr. Mayes estimates that 6-12 months will be required to complete development of the grain sensor. Dr. Mayes' first documentation of his idea, in terms of a set of drawings or other specific description of how the invention was to be implemented, was not made at the earliest until he prepared a drawing sketch on or about January 24, 1996.

It is also evident that even as late as January 26, 1996, which is less than one year before the December 30, 1996 filing date of this application, Dr. Mayes had not yet even conceived of several details of how the optical head was to be adapted to a combine. These include, at a minimum,

- (a) how to adapt an optical sensor head to fit on a combine or other mobile agricultural equipment so as to irradiate a flowing stream of agricultural product as it is being harvested

which is a feature that appears in all of the claims of the present invention, and

- (b) how to select and orient the fiber optic;
- (c) the specific type of optical detector to use;
- (d) the wavelength region which would be best to use in the intended application; and
- (e) how to arrange the components to obtain a reference light measurement

which are features that appear in certain dependent claims.

In the present case therefore, unlike in the *Pfaff* case, there were no drawings or other enabling descriptions of the claimed invention prepared prior to the critical date. Thus, the invention cannot be said to have been on-sale.

There is also a very recent decision from the United States Court of Appeals for the Federal Circuit in *Scaltech, Inc. v. Retac/Tetra LLC*, Nos. 97-1365, -1480, Slip. Op. at 9 (Fed.Cir. June 4, 1999), where it was held that if the thing offered for sale "inherently possesses" each of the claim limitations, then the invention might still be considered to be on sale. As we have pointed out above, there are at least three features {(a), (b), (c), (d) and (e) above} which are not inherent in every photospectrometer. Therefore, the reasoning of the *Scaltech* case does not apply in this situation.

B. The Micro-Trak Letter was a Not Public Disclosure of the Invention

There is another bar to patentability found in 35 U.S.C. §102(b), the so-called "prior publication" rule, which states that an invention cannot be patented if it was described in a printed publication more than a year before the filing date. However, as discussed below, Dr. Mayes' December 5, 1995 letter to Micro-Trak did not constitute such a publication.

We first note that the Micro-Trak letter was not a publication in the normal sense, it being a matter of private correspondence between Dr. Mayes and Micro-Trak. A document must typically be accessible in some way to the public in order for it to be considered a "publication." For example, in a case where six copies of a document seeking financial backing for an idea were sent out, the court held this was not a sufficient distribution to constitute a "publication". *Preemption Devices, Inc. v. Minnesota Mining and Manufacturing Co.*, 732 F.2d 903, 221 USPQ 841, 843 (Fed.Cir. 1984). This is similar to the present situation, where Dr. Mayes' December 5, 1995 letter also sought funding to develop his idea further, but was circulated to only a few people.

Furthermore, even assuming that the letter was a publication, as already explained above, this letter alone does not teach the invention, and particularly enabling one of skill in the art how to make and use the invention. In order for a publication to be sufficient to become a bar to

patentability, it must contain a sufficient disclosure of the invention to enable one of skill in the art to make the claimed invention without further research or experimentation. *In re Donohue*, 766 F.2d 531, 226 USPQ 453 (Fed.Cir. 1985); *Solarex corp v. Arco Solar, Inc.*, 870 F.2d 642, 10 USPQ2d 1247 (Fed.Cir. 1989).

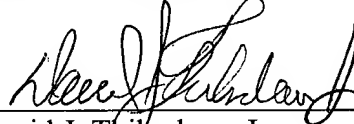
As to the particular facts in the present case, the December 5, 1995 letter does not teach at least one limitation of every one of the claims. Specifically, the December 5, 1995 letter therefore contains no description of the configuration of the components of the spectrometer, i.e., the specific type of optical detector to use and its preferred wavelength, how to adapt the sensor head to fit onto a combine or other mobile agricultural equipment; how to orient the fiber optic; how to arrange the components to obtain a reference light measurement; or numerous other details contained in Dr. Mayes' patent application.

As set forth in Dr. Mayes' earlier Declaration dated March 8, 1999 (Exhibit B hereto), the spectrophotometer systems in use prior to December 1995 were laboratory instruments, and were not designed for or intended to be used with or mounted within mobile agricultural equipment such as a combine or harvester or otherwise to be suitable for use in analyzing the properties of grain as it being harvested in the field. It was many months later in 1996 before even Dr. Mayes himself was able to complete a working model. The December 5, 1995 letter is therefore not the type of enabling disclosure which is required to prove that an invention was anticipated or obvious.

The same conclusion must be reached even if it could be argued that the December 5, 1995 letter was a public use. One must take care to analyze just what the invention is that is said to be the subject of an invalidating use; if the use does not describe the invention suitably to place the public in possession of the invention, it cannot be an invalidating use under 35 USC §102 or §103. *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed.Cir. 1983).

In conclusion, we believe that Dr. Mayes activities which occurred more than one year prior to the earliest filing date of the application were not sufficient to give rise to a finding that the claimed invention was either on-sale or in public use more than one year before the filing date.

Respectfully submitted,



David J. Thibodeau, Jr.

Reg. No. 31,671

Hamilton Brook Smith & Reynolds, P.C.

2 Militia Drive

Lexington, MA 02421

(781) 861-6240

(781) 861-9540

Lexington, Massachusetts

Dated: August 30, 1999